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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,743	03/24/2004	John Armstrong	EFIM0581	5863
22862	7590	06/11/2010		
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER CHEEMA, UMAR	
			ART UNIT 2444	PAPER NUMBER
			NOTIFICATION DATE 06/11/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eptomatters@glenn-law.com

Office Action Summary

Application No.

10/808,743

Applicant(s)

ARMSTRONG ET AL.

Examiner

UMAR CHEEMA

Art Unit

2444

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is response to the Amendment filed on 03/09/2010. Claims 1, 3, 5-8, and 11-13 are pending with claim 1 being further amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3, 5-8 and 11-13 have been fully considered but are moot in view of new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's amendment, "automatically registering identification information," is not supported by the specification in such a way that one of the ordinary skill person in the art would have recognized the invention. Applicant is respectfully advised to point out from specification to provide appropriate support for such limitations in future response.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim element “automatically registering information, sending a request, message processing mean and configuration etc.” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 3, 5-8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spinks et al. (hereinafter Spinks), U.S. Patent Pub. No. 2001/0029534, in view of Trossen, U.S. Patent Pub. No. 2004/0003058, and further in view of Hall et al. (hereinafter Hall), U.S. Patent Pub. No. 2002/0133555 and further in view of Rendezvous (provided in IDS).
6. Regarding claim 1, Spinks discloses a system for controlling access to a printing environment comprising: a directory server coupled to a third network the directory server comprising: a memory (**i.e. 14**) (**see Fig. 1**); and a message processor (**i.e. 12**) (**see Fig. 1**) adapted to register the identification information in a directory table in the memory (**connected with directory services node (60), see Fig. 1**); at least one printing device (**i.e. (74) and (92)**) coupled to a first network (**30**), (**see Fig. 2**), information (**100**) identifying the network device on the first network, (**pg. 5, par. [0068]**); and a registration and query processor (**i.e. 12**) for providing the identifying information to a directory server (**84**) to register the network device on said directory server, (**pg. 5, par. [0068]**, **pg. 6, par.'s [0080], [0081]**, also see Fig.'s 2 and 7).

7. Spinks further discloses the directory server may provide directory services as were well known in the art at the time of the present invention, (pg. 4, par.'s [0057], [0058], also see pg. 5, par. [0068]).

8. Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the registration and query processor transmitting query messages regarding the first network to said directory server. Nevertheless, a processor transmitting query messages regarding a first network to a directory server was well known in the art at the time of the present invention.

9. In analogous teachings, Trossen exemplifies this where Trossen teaches a processor (i.e. 30) transmitting query messages regarding a first network (i.e. company network) to a directory server (14), (pg. 3, par.'s [0028], [0029], also see Fig. 2).

10. Thus, given the teachings of Trossen, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the registration and query processor transmitting query messages regarding the first network to said directory server. As was known in the art, this would have advantageously allowed for service discovery on the first network by the registration and query processor, (Trossen, pg. 1, par. [0007]).

11. Although Spinks discloses substantial features of applicant's claimed invention, Spinks further fails to expressly disclose: wherein the network device is located inside a firewall, and the directory server is coupled to a third network and is located outside the firewall. Nevertheless, a network device being located inside a firewall, and a directory server being coupled to a third network located outside the firewall, were well known features in the art at the time of the present invention.

12. In analogous teachings, Hall exemplifies this where Hall teaches a network device (i.e. **company device**) being located inside a firewall, (pg. 3, par. [0031]); and, a directory server (108) coupled to a third network (i.e. **a network external to the company network**) located outside the firewall, (pg. 3, par. [0028]).

13. Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the network device is located inside a firewall, and the directory server is coupled to a third network and is located outside the firewall. As was known in the art this would have advantageously protected the network device by limiting access to the network device (Hall, pg. 3, par. [0031]), while further allowing for the directory server to be accessed publicly by other network devices outside the network of the network device without compromising the security of the network device, (Hall, pg. 3, par. [0028]).

14. Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: means for automatically the registration of identification information for printing device on directory server without intervention by an administrator and query/replying all configuration information necessary without intervention by an administrator. Nevertheless, automatically the registration of identification information for printing device on directory server without intervention by an administrator and query/replying all configuration information necessary without intervention by an administrator were well known in the art at the time of the present invention.

15. In analogous teachings, Rendezvous exemplifies this where Rendezvous teaches means for automatically the registration of identification information for printing device on directory server without intervention by an administrator and query/replying all configuration information

necessary without intervention by an administrator (see at least pgs. 2-3, also figures on page 3; section How Rendezvous Works: wherein exemplifies how printer device has been automatically configured on the network; Rendezvous communication further explains query and response packets contain information needed for service discovery etc.).

16. Thus, given the teachings of Rendezvous, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the registration and query processor transmitting query messages regarding the first network to said directory server. As was known in the art, this would have advantageously to minimize network traffic while achieving timely notification and discovery of services on a network (see **Rendezvous: pg. 4; lines 12-13**).

17. Regarding claim 2, (Cancelled).

18. Regarding claim 3, Spinks discloses the network device comprises a network printer (92) coupled to the first network and the directory server, (pg. 4, par. [0061], pg. 5, par. [0068], also see Fig. 2).

19. Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer. Nevertheless, it was well known in the art that a network printer could comprise an inkjet printer, laser printer, wide format printer, or dot matrix printer.

20. Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer. As was known in the art, a printer such

as a laser printer for example, would provide fast, high quality print outs for a user of the printer. Using such a printer in the teachings of Spinks would have allowed for the specific type of printer to register identifying information on the directory server so the printer may be found, in case the physical location of the printer changes for example, (Spinks, pg. 2, par.'s [0016]-[0018]).

21. Regarding claim 4, (Cancelled).

22. Regarding claim 5, Spinks discloses the network device further comprises a network connection (26, 28) for coupling to the first network, (pg. 3, par. [0047]).

23. Regarding claim 6, Spinks discloses "any network 30, 50 may be part of, and connect to the Internet 64", (pg. 4, par. [0058]), and "a system 70 may be installed at a network site 72, which may be an office or building belonging to an organization or the like", (pg. 4, par. [0059]).

24. Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the first network comprises a local area network. Nevertheless, local area networks were well known in the art at the time of the present invention for connecting personal computers, printers and other devices inside buildings or on campuses for example.

25. Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the first network comprises a local area network. As was known in the art, this would have advantageously provided a network that was personal and/or specifically used for a company or organization. Using such a network in the teachings of Spinks would have provided a device registration process that would allow for a device in a local area network to be found, in case the physical location of the device changes for example, (Spinks, pg. 2, par.'s [0016]- [0018]).

26. Regarding claim 7, Spinks discloses the first network comprises a plurality of interconnected networks (30, 50), (pg. 4, par. [0060]).
27. Regarding claim 8, Spinks discloses the first network is coupled to a second network (64) that comprises any of a wide area network, global network, public network, or the Internet, (pg. 4, par. [0058]).
28. Regarding claims 9-10, (Cancelled).
29. Regarding claim 11, Spinks discloses the identifying information comprises an address, (pg. 6, par. [0084]).
30. Regarding claim 12, Spinks discloses the identifying information comprises an address of the network device on the first network, (pg. 6, par. [0084]).
31. Regarding claim 13, Spinks discloses the first network is coupled to a second network (50) (pg. 4, par. [0060]), and the identifying information comprises an address of the first network on the second network, (pg. 6, par. [0084]).
32. Regarding claim 14-24, (Cancelled).

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit
2444

/U. C./
Examiner, Art Unit 2444